

REMARKS

This Response to the Office Action mailed August 13, 2009, is believed to address each and every issue raised in the Action. A favorable reconsideration of the application is respectfully requested.

Claim Status

Upon entry of the amendment, which is respectfully requested, claims 7 and 12-29 will be pending. Claim 7 has been amended to more clearly set forth the subject matter of the present invention by reciting a “clear aqueous cosmetic additive composition” and improve wordings. Support for the amendment to claim 7 can be found in the specification, for example, at page 4, lines 5-14.

Formal Matters

Applicants thank the Examiner for considering the Information Disclosure Statements filed January 21, 2009 and May 13, 2009 and for returning initialed copies of the PTO/SB/08 forms.

Statement of Substance of Interview

Applicants thank the Examiner for the telephonic interview conducted on October 5, 2009. Applicants received and thank the Examiner for Examiner Interview Summary, mailed October 13, 2009. Applicants state that the statements provided in the Interview Summary of

October 13, 2009, describe accurately the contents of the interview conducted on October 5, 2009.

It is respectfully submitted that the instant STATEMENT OF SUBSTANCE OF INTERVIEW complies with the requirements of 37 C.F.R. §§1.2 and 1.133 and MPEP §713.04.

It is believed that no petition or fee is required. However, if the USPTO deems otherwise, Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Response to Claim Rejections under 35 U.S.C. § 103

On page 2 of the Action, claims 7 and 12-29 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over US 6,355,232 to Kaneko et al and EP 092852 (hereinafter EP '852) in view of US 5,294,444 to Nakamura et al., or Nakamura in view of Kaneko and EP '852, and further in view of US 4,992,266 to Knoll.

In response, claim 7 is amended in order to more clearly set forth the claimed subject matter. No new matter is introduced.

Applicants respectfully traverse the rejections. Currently amended claim 7 recites a "clear aqueous cosmetic additive composition." None of the cited references, either taken alone or in combination, disclose or render obvious the features of the presently claimed invention.

Kaneko, EP '852, and Nakamura were previously cited by the Examiner and discussed in detail by Applicants in previous correspondences. Therefore, Applicants' previous arguments are incorporated by reference into this Amendment.

In addition, in order to assist the Examiner in understanding the differences between the claimed method and the processes taught by cited references, a claim chart is provided below.

Claim 7	Kaneko	EP '852	Nakamura	Knoll
<p>1. A method for producing a <i>clear</i> cosmetic additive composition, which is <i>free of ionic surface agent</i>, comprising</p> <p>forming a lipid composition <i>consisting essentially of</i> (A) ceramide of formula (I) and, optionally (II);</p> <p>(B) a long-chain fatty acid having 12 to 24 carbon atoms, and</p> <p>(C) a nonionic lipophilic or hydrophilic surface active agent, and</p> <p>(E) optionally a sterol compound, wherein components (A), (B), (C) and optionally (E) are uniformly mixed while heating at 80 to 120°C to form the lipid composition;</p> <p>adding (F) a polyhydric alcohol which has been heated to 80 to 120°C to the lipid composition and mixing components (A), (B), (C) and optionally (E) with the (F) polyhydric alcohol while heating</p> <p>thereafter further adding water which has been heated to 80 to 100°C; and</p> <p>then permitting the resulting mixture to cool to room temperature</p>	<p><i>No teaching of a method of making a clear cosmetic additive composition.</i></p> <p>Simply describes a production of optically active ceramide and its water barrier ability tests</p> <p>Skin protective agent comprising</p> <p>(A) ceramide,</p> <p>(B) optionally fatty acid,</p> <p><i>- no surface agent,</i></p> <p>(E) optionally sterol</p> <p>-</p> <p>-</p> <p>-</p> <p>Test 1 show heating at 90 °C with vigorous shaking does not allow the ceramide soluble (i.e., not transparent) in cosmetic solvent such as oleic acid or ethanol</p>	<p><i>No teaching of making a clear cosmetic additive composition.</i></p> <p><i>Working examples use an anionic surface agent</i> such as sodium stearate.</p> <p>Hair composition comprising</p> <p>(A) ceramide,</p> <p>(B) optionally fatty acid,</p> <p>(C) ionic surface active agent,</p> <p>(E) optionally sterol agent</p> <p>-</p> <p>-</p> <p>Working examples use anionic surface active agent</p>	<p><i>- No teaching of clear composition. - requires use of ionic surface agent</i></p> <p>Mixing</p> <p>(A) pseudo-ceramide,</p> <p><i>no long chain fatty acid</i></p> <p>(C) nonionic surface agent, and</p> <p>(D) <i>ionic surface agent</i></p> <p>at 85-90 °C.</p> <p>-</p> <p>adding hot water</p> <p>cooling the mixture</p> <p>Requires use of ionic surface agent</p>	<p>- a method of reducing ocular irritancy of an aqueous shampoo <i>consisting essentially of about 1-20% of at least one anionic surfactant</i>, by including within the shampoo from about 0.005% to 5% of ethylene oxide homopolymer.</p> <p>No teaching of a method of making a clear cosmetic additive containing certain ceramide.</p> <p>-</p> <p>-</p> <p>-</p> <p>The <i>composition still requires to contain anionic surface active agent.</i></p>

1. The combined teachings of cited references fail to teach all and every element of claim 7

As can clearly be seen in the above chart, the combined teachings of the cited references fail to teach all and every limitations of independent claim 7.

That is, first, all of the cited references require the use of “ionic surface active agent,” as opposed to claim 7 of the instant application, which requires the composition be free of an ionic surface active agent.

Knoll reference is cited by the Examiner as teaching that anionic surfactants have been known to cause irritation, in support of the Examiner’s assertion that one skilled in the art would have been motivated to exclude the anionic surfactant. However, Applicants respectfully bring the Examiner’s attention to the fact that Knoll, even though showing the problem (i.e., anionic surfactants cause eye irritation), fails to exclude the anionic surfactant from the hair composition. That clearly indicates that the use of anionic surfactant has been considered as an essential component. Such is evident from the fact that all of the cited references require the use of ionic surfactant in cosmetic compositions. On the contrary, claim 7 of the instant application unambiguously and expressly excludes use of ionic (including anionic) surfactants.

Second, the combined teachings of the cited references fails to teach all of the steps recited in claim 7 of the instant application. The method defined in claim 7 requires certain steps to preparing a clear cosmetic additive composition, which is a clear composition and is free of an ionic surfactant. As clearly can be seen in the above chart, the combined teachings of the cited references fail to teach all of the steps as exactly recited in claim 7.

2. Exclusion of ionic surfactant from compositions of cited references would be unsatisfactory for intended purposes of cited references

According to Knoll, it appears that the inventors were aware of the problem of using anionic surfactants in hair compositions, i.e., causing eye irritation. Nevertheless, the compositions of Knoll require the use of the anionic surfactant. The solution to solve the problem as adopted by Knoll was to add an additional ingredient to neutralize the irritation caused by anionic surfactant, rather than removing ionic surfactants. That clearly indicates that the use of anionic surfactant has been considered as an essential component and, desired properties of the hair compositions of Knoll could not be obtained without using anionic surfactant.

As shown above in the chart, all of the other cited references also require the use of ionic surfactant in cosmetic compositions.

“[I]f [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The prior art must be considered in its entirety, including disclosures that teach away from the claims and the Examiner’s assertion that the present rejection provides a motivation to exclude an ionic surfactant because of its skin and eye irritating properties is simply incorrect. (See MPEP 2141.02). None of the cited references teach or suggest that an ionic surface active agent can be excluded from their compositions.

Therefore, neither of EP ‘852, Nakamura, Kaneko, or Knoll, either alone or in combinations, renders obvious the subject matter defined in the present independent claim 7,

which excludes an ionic surfactant, requires the composition be a clear aqueous composition, and requires specific process steps.

3. The difference in the usage of the claimed subject

As discussed above, claim 7 is amended to recite “cosmetic additive,” in order to more clearly set forth the claimed subject matter. This amendment also address the Examiner’s statement that Applicant’s argument that the claimed composition is different from the final consumer products disclosed by Nakamura or other references is not persuasive, because claim 7 does not expressly indicates so. Applicants believe that the current amendments to claim 7 clearly indicates the difference.

4. Conclusion

Accordingly, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 103 rejections of claim 7. Dependent claims 12-29 also should be patentable over the cited references, at least for the same reasons of the patentability of independent claim 7.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number **202-775-7588**.

AMENDMENT UNDER 37 C.F.R. § 1.114(c)
U.S. Application No.: 09/848,225

Attorney Docket No.: Q64175

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

/Sunhee Lee/

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON DC SUGHRUE/265550

65565

CUSTOMER NUMBER

Date: January 12, 2010

Sunhee Lee
Registration No. 53,892